# REMARKS

This paper responds to the *Office Action* dated May 1, 2009. Claims 1, 12, 20, and 27 are amended. Claims 32 and 35 were previously canceled, and no claims are added. As a result, claims 1-31, 33, and 34 remain pending in this application.

## *§ 112 Rejection of the Claims*

Claims 1-31, 33, and 34 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserted that the independent claims require "a presentation description 'that define[s] a plurality of different manners in which a portion of said first image and a portion of said second image may be combine.'" Referring to FIG. 4, the Examiner found that "the specification describes that separate portions of a first image (eg, portions 406, 408, 410, and 412 of image 404) may be combined with a portion of the second image (402) in a single way." Thus, the Examiner concluded that the specification "does not describe that the two portions of the two images can be combined in different ways, but rather that separate portions of two images may be combined in a single way per combination." *Office Action* at 3-4.

In order to clarify language of the claims, independent claims 1, 12, 20, and 27 have been amended to recite a presentation description comprising a set of instructions that define a manner in which a portion of said first sequence of images and a portion of said second sequence of images may be combined, the manner in which the sequences of images are combined being selected from a plurality of different manners of combinations based upon user preference information in said system. The amended portions of the independent claims now recite similar limitations as previously recited, for example, in the claims of the responses filed on December 10, 2007 and May 22, 2008, which the Examiner found not to include new matter.

Since all elements of the present claims 1, 12, 20, and 27 are found in the specification as filed, Applicants respectfully request the Examiner to reconsider and withdraw the rejection made under 35 U.S.C. §112 of claims 1, 12, 20, and 27. Claims 2-11, 13-19, 21-26, and 28- 31, 33, and 34 depend from claims 1, 12, 20, and 27. No additional rejections have been made with reference to these dependent claims other than depending from a claim allegedly not in

compliance with 35 U.S.C. §112. Therefore, they too can be considered as meeting the requirements under 35 U.S.C. §112, first paragraph. Thus, Applicants request that the rejection with regard to claims 2-11, 13-19, 21-26, and 28- 31, 33, and 34 also be withdrawn.

## § *103 Rejection of the Claims*

Claims 1-31, 33 and 34 were rejected under 35 U.S.C. § 103(a) as being obvious over *Cheok* (U.S. Patent No. 6,934,906) in view of *Shahine* (U.S. Patent No. 7,082,576). Since a *prima facie* case of obviousness has not been properly established, Applicants respectfully traverse the rejection.

The U.S. Supreme Court decision of *KSR v. Teleflex* provides a tripartite test to evaluate obviousness.

> A rationale to support a conclusion that a claim would have been obvious is that **all the claimed elements were known in the prior art** and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*See KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007)). Emphasis added.)

Applicants will show that the cited references, either singly or in combination, neither teach nor suggest all limitations of Applicants' claims.

Claim 1 recite, in part "the manner in which the images are combined being selected from a plurality of different manners of image combinations based upon user preference information in said system." Independent claims 12, 20, and 27 contain similar limitations. The Examiner acknowledges that "Cheok does not further explicitly teach that the selected manner is chosen based on user preference information in the system." *Office Action* at 6. However, the Examiner contended that

> Shahine teaches a device for composing a displayed scene using a presentation description to arrange data objects (Abstract), wherein the arranged objects include images (col. 13, l. 20-29), in a plurality of manners based on a priority associated with the object (Abstract), wherein the priority is determined based on user preference information stored in the device (col. 8, l. 21-35).
> *Office Action* at 6.

Thus, "it would have been obvious to have modified Cheok's presentation descriptions for arranging image objects with Shahine's teaching of a dynamic arrangement of objects based on preference information . . . for purposes of displaying the most important objects to the user." *Office Action* at 6.

A closer review of these cited portions of *Shahine* shows that *Shahine* does not teach the manner in which the images are combined being selected from a plurality of different manners of image combinations based upon user preference information in said system. Instead, *Shahine* is merely directed to a system "for dynamically displaying data objects or 'information' on a computer display device based on a predefined priority associated with each individual element of the information. Consequently, ***more important information is displayed prior to less important information***." *Shahine, Abstract*. Thus, *Shahine* "is used to display a summary of available information based on a predefined priority associated with each portion or element of that information." *Shahine, Abstract*. There is absolute no teaching or suggestion in *Shahine* to select a single manner in which the images are combined being selected from a plurality of different manners of image combinations based upon user preference information in said system. *Shahine* merely ranks data object such that ***data objects will be displayed in order of importance***. This is further illustrated at col. 8, lines 21-35 of *Shahine* which discusses a "prioritized data module 410 [that] is basically a database of prioritized data objects …assigned a priority based upon a predefined priority list" which may be user configurable.

Although the Examiner cited to portions of the *Shahine*, there is no rational argument providing a legal nexus between the cited portions *Shahine* and Applicants' claims. *Shahine* only describe prioritizing data objects for display whereby more important information is displayed prior to less important information. Consequently, *Shahine* attempts "to dynamically arrange and display as much of the information as will fit within the single window based on the predefined priority associated with each portion of element of the information." *Shahine*, col. 2, lines 61-65. *Shahine* in no way teaches or suggests selecting a single manner in which the images are combined being selected from a plurality of different manners of image combinations based upon user preference information in said system.

In fact, *Shahine* does not even contemplate combining data objects such as that discussed in *Cheok,* but merely displays data objects in order of importance. In the Response to Argument

section of the *Office Action*, the Examiner contended that "Cheok teaches that a combined scene is context dependent, and different information is shown based on the context . . . Therefore it is clear that Cheok defines a plurality of different manners of combining information based on context." However, context in *Cheok* is based "upon whether the user selects the Search, View or Reserve option." *Cheok*, col. 3, lines 45-47. Thus, it would not have been obvious to combine *Cheok* with *Shahine* in order to obtain the limitation whereby "the manner in which the images are combined being selected from a plurality of different manners of image combinations based upon user preference information in said system." At most, the combination of *Cheok* and *Shahine* will render a system that will combine information in a manner to display more important information to a user prior to displaying less important information based on a user configurable priority list and based on the context selected by the user.

Since Applicants have shown that not all the claimed elements were known as required by *KSR*, either by *Cheok* singly or in combination with *Shahine*, Applicants respectfully request the Examiner withdraw the rejection under 35 U.S.C. §103 with regard to independent claims 1, 12, 20, and 27.

Applicants respectfully disagree with the Examiner's rejection of claims 2-11, 13-19, 21-26, and 28- 31, 33, and 34 for at least the reason that claims 2-11, 13-19, 21-26, and 28- 31, 33, and 34 depend from otherwise allowable independent claims as discussed in detail herein. "A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." *35 U.S.C. §112 ¶4.* As such, Applicants contend that dependent claims 2-11, 13-19, 21-26, and 28- 31, 33, and 34 are allowable for at least the same reason as the independent claim from which they depend.

**AMENDMENT AND RESPONSE UNDER 37 C.F.R § 1.111**
Serial Number:10/609,000
Filing Date: June 26, 2003
Title: Video combiner

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Dkt: 2050.123US1

# CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone the undersigned representative at (408) 278-4057 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN  55402--0938
(408) 278-4040

Date ___July 31,2009___   By ___/Susan Yee/___
                               Susan Yee
                               Reg. No. 41,388

CERTIFICATE UNDER 37 CFR 1.8:  The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this __31__ day of July, 2009.

John D. Gustav-Wrathall
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Name                                       Signature